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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,915	01/17/2001	Yasuo Tano	4084-2163	5564

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THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS, MO 63101

EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SUPPLEMENTAL
Office Action Summary

Application No.

09/761,915

Applicant(s)

TANO ET AL.

Examiner

Vy Q. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,9-15 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,9-15 and 21-33 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: Amendment A/#6 (original application 09/058,183).

DETAILED ACTION

Oath/Declaration

Upon filing of the Application Data Sheet and the originally executed Oath/Declaration, a new Oath/Declaration is not required. The objection to Oath/Declaration as defective has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

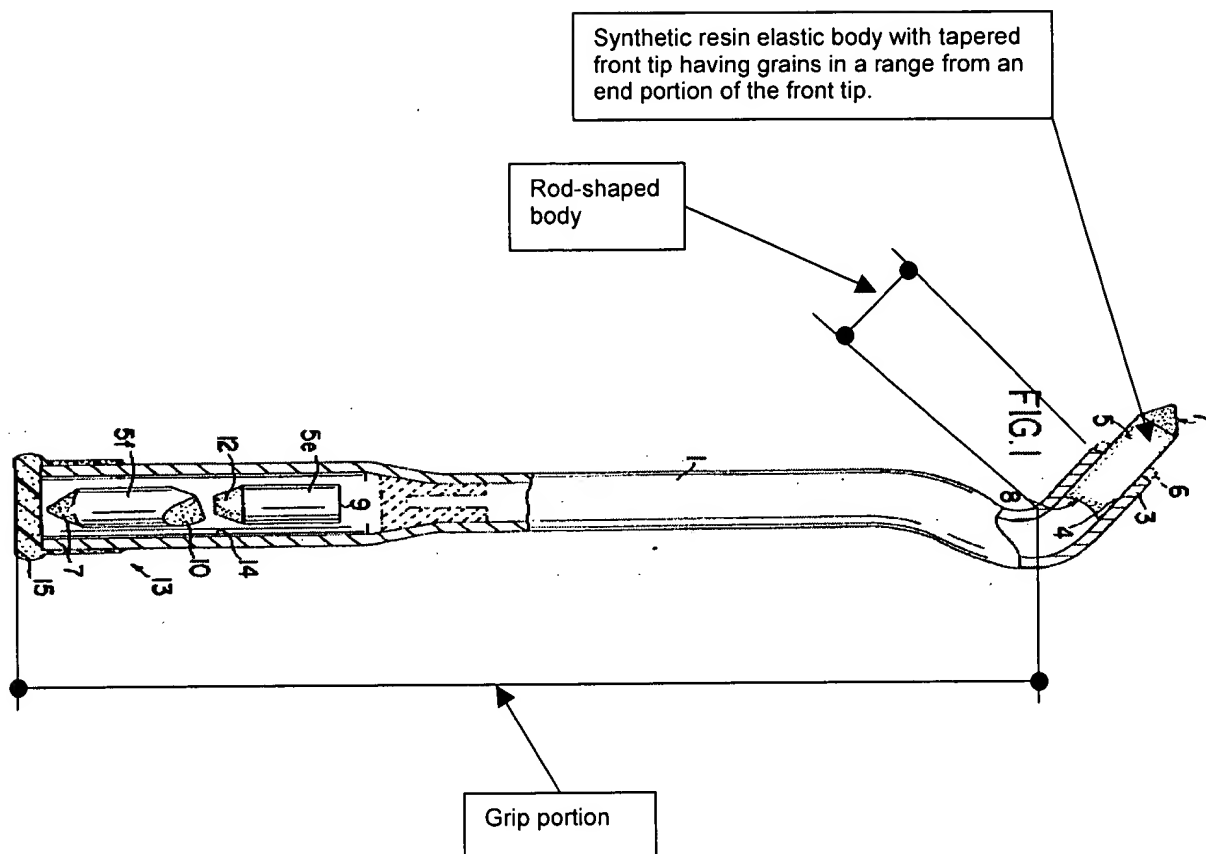
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by VARAINE (5,118,291).

As to claim 26, VARAINE (see Fig. 1 reproduced on next page; abstract) discloses every structural limitation as recited in the claim.

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Claim Rejections - 35 USC § 251

Present independent claims **1, 9, 12, 21, and 26** and dependent claims **3-4, 7, 10-11, 13-15, 22-25 and 27, 29-33** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429,

1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 1 (original application 09/058,183) was amended to recite (I). **“a hollow tapered front tip”** (see line 7, claim 1 of surrendered U.S. Pat. 5,921,998) and (II). **“grains are located in a range of 0.5mm to 3.0mm from an end portion of said front tip”** (see lines 8-12, claim 1 of surrendered U.S. Pat. 5,921,998) to overcome the 102(b) rejection entered on 12/04/1998 (application 09/058,183) as being anticipated by SHIMIZU (U. S. Pat. 3,809,101). **In the argument filed 04/10/1998 (from line 13, page 5 to line 4, page 6 of attached Amendment A/#6, dated April 10, 1998),** the applicants argued that SHIMIZU does not disclose the features (I) and (II) above, and therefore, amended claim 1 was clearly defined over SHIMIZU. The amendment and argument was presented to obviate the rejection and was convincing, therefore the amended claim 1 was allowed and issued in U.S. Pat. 5,921,998 with features (I) and (II) in claim 1 (see column 6, lines 8, and 11-12, U.S. Pat. 5,921,998). According to the Applicants' argument **filed 04/10/1998 (from line 13, page 5 to line 4, page 6 of attached Amendment A/#6, dated April 10, 1998),** features (I) and (II) are considered

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as surrendered subject matters to overcome the prior art of SHIMIZU rejection. See MPEP 1412.02.

Present independent claims **1, 9, 12, 21** and **26** now do not require the tapered tip or taper of the device to be hollow, nor require the range from 0.3 mm to 3.0mm for the grain to be fixed to the tapered tip or taper of the elastic body. The omission of the feature **(I)** and/or **(II)** above in the independent claims **1, 9, 12, 21** and **26** of the current application presents an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Present dependent claims **3-4, 7, 10-11, 13-15, 22-25** and **27, 29-33** now do not include **both** features **(I)** and **(II)**, therefore are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

Allowable Subject Matter

Claim 28 includes both surrendered features **(I)** and **(II)** and therefore is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments and amendment entered as paper #9/B have been fully considered but they are not persuasive.

From the history of the prosecution of the parent case (application 09/058,183), the only independent claim 1 of US application 09/058,183 was allowed because the applicant's amendment to include features (I) and (II) in the claim (please see the arguments filed 04/10/1998, from line 13, page 5 to line 4, page 6 of previously attached Amendment A/#6, dated April 10, 1998 in the previous "Office Action"). In the arguments filed 04/10/1998 in the parent case, the applicants expressly relied on features (I) and (II) to define the instant invention over the prior art of rejection, i.e. SHIMUZU.

Because one of ordinary skill in the art does not expect to make SHIMUZU nail file having both features (I) and (II), therefore, amendment of claim 1 of the application 09/058,183 to include features (I) and (II) was allowable because the amended claim 1 of application 09/058,183 was clearly defined over SHIMUZY reference.

As to the independent claims, feature (II) is broadened by the recitations "a range from an end portion of said tip" (line 9, claim 1 and lines 8-9, claim 9), "a range from an end portion of said distal end portion" (line 10, claim 12), "a range from an end portion of the tapered tip" (line 8, claim 21) and "a range from an end portion of said front tip" (line 7, claim 26). The recitations in the independent claims only specify one end of a range

(from an end portion) but not the other end of the range, therefore, they do not really specify any range in the claims.

Independent claims 21 and 26 as now amended, hollowness of the tapered tip of the elastic body in feature (I) disappears.

It is possible that a claim in a reissue application can avoid recapture rejection if the reissue claim recites a broader form of a surrendered limitation [*Ex Parte Eggert*, Appeal No. 2001-0790 (BD. Pat. App. & Inter. May 29, 2003)]. However, at least in independent claims 21 and 26, the surrendered feature "hollow" were not in the claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

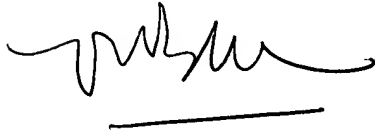
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke at the end.

VQB
October 21, 2003.